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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/566,101

08/10/2006

Ramon Merce Vidal

284024US-0-PCT

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22850

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02/12/2008

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.

1940 DUKE STREET

ALEXANDRIA, VA 22314

EXAMINER

RAHMANI, NILOOFAR

ART UNIT

PAPER NUMBER

1625

NOTIFICATION DATE

DELIVERY MODE

02/12/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/566,101

Applicant(s)

MERCE VIDAL ET AL.

Examiner

NILOOFAR RAHMANI

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-14 and 85-96 is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☒ Claim(s) 8,15-17,76,77,84 and 97-100 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 1-18,20,21,23,24,29-31,36,43,45,46,48,49,51,52,57-59,64,71 and 73-104.

Continuation of Disposition of Claims: Claims rejected are 1-7,18,20,21,23,24,29-31,36,43,45,46,48,49,51,52,57-59,64,71,73-75,78-83 and 101-104.

DETAILED ACTION

1. Claims 1-18, 20-21, 23-24, 29-31, 36, 43, 45-46, 48-49, 51-52, 57-59, 64, 71, 73-104 are currently pending in the instant application and claims 19, 22, 25-28, 32-35, 37-42, 44, 47, 50, 53-56, 60-63, 65-70, 72 are cancelled.

Priority

2. This application is filed on 08/10/2006, which is a 371 of PCT/EP04/08510, filed on 07/29/2004, which claims benefit of the priority document SPAIN 200301810, filed on 07/30/2003.
3. The rejection of claims 20-45, and 48-73 under 35 U.S.C. 101 is withdrawn in view of the applicant's amendment on paper dated 07/24/2007.
4. The rejection of claims 18-45, and 46-73 under 35 U.S.C. 112, second paragraph is withdrawn in view of the applicant's amendment on paper dated 07/24/2007.
5. The rejection of claims 1-73 under 35 U.S.C. 112, first paragraph for the terms "solvates" or "hydrates" is withdrawn in view of the applicant's amendment on paper dated 07/24/2007.
6. The rejection of claims 1-7, 74-75, 78-83 under 35 U.S.C. 102(b) is maintained for reason of record. Applicants argue that in the Lanconde et al compound, the 3,4,5-trimethoxyphenyl moiety is analogous to the presently-recited R¹ group. However, in claim 1, R¹ represents a -NR⁸R⁹ radical or, in effect, an optionally substituted mono- or bicyclic cycloaliphatic ring system. Thus, presently-recited R¹ is not inclusive of phenyl per se, or any substituted

Art Unit: 1625

phenyl group. It is examiner's position that cycloaliphatic radical can encompassed phenyl. Therefore, the rejection is maintained.

7. The rejection of claims 18, 20-21, 23-24, 29-31, 36, 43, 45-46, 48-49, 51-52, 57-59, 64, 71, 73, 101-104 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement for the term "prophylaxis" is maintained for reason of record. Applicants argue that vaccines are just one example of them, since they produce active immunity to prevent an infection. Therefore, the instant claims do encompassed the vaccines, this has not enabled by the instant specification. Therefore, the rejection is maintained.

8. The rejection of claims 18, 20-21, 23-24, 29-31, 36, 43, 45-46, 48-49, 51-52, 57-59, 64, 71, 73, 101-104 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement is maintained for reason of record. Applicants argue that the role of the 5-HT6 receptor in the ingestion of food has been disclosed in the prior art, as acknowledged at page 2, lines 27-28 of the specification. It is therefore, reasonable to suggest that the skilled person would be guided into testing the activity of the compounds of invention on eating disorders, since they exert an inhibitory activity on the 5-HT6 receptor. It is examiner's position that there is no nexus between the 5-HT6 receptor and bulimia, anorexia, cachexia, type II diabetes.

Applicants argue that in the Bentley et al. abstract summarizes preliminary findings on the influence that the 5-HT6 receptor may have in feeding patterns and body weight in rats. It is examiner's position that this article has not shown

Art Unit: 1625

definitely link between 5-HT6 receptor and feeding patterns and body. There is no nexus between the 5-HT6 receptor and body weight.

Applicants argue that Woolley et al. described in the specification, further provides results and data supporting the results discussed above. It correlates the administration of a 5-HT6 antisense oligonucleotide and selective 5-HT6 antagonist Ro 04-6790 with reduced body weight, the first one also being related to a decrease in food consumption. Both compounds have affinity for the receptor, with Ro 04-6790 being an antagonist. It is examiner's position that none of the above documents have provided the nexus between the receptor and bulimia, anorexia, cachexia and type II diabetes.

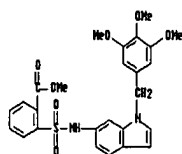
9. *Claim Objections*

Claims 8,15-17,76-77, 84, and 97-100 are objected to as being dependent upon a cancelled base claims 1, but would be allowable if rewritten in independent form including all of the limitations of the base claims and any intervening claims.

10. *Allowable Subject Matter*

Claims 9-14, and 85-96 are patentable over Laconde et al., Journal of enzyme inhibition and medicinal chemistry, 2003, Vol. 18, pages 89-94. The reference teaches

Art Unit: 1625



, which has

different R¹ than the instant claims. Therefore, the claims are free of prior art.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**.

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Niloofar Rahmani whose telephone number is 571-272-4329. The examiner can normally be reached on Monday through Friday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres, can be reached on 571-272-0867. The fax

Art Unit: 1625

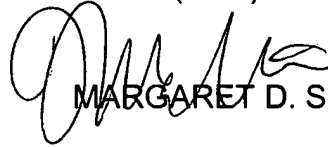
phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NILOOFAR RAHMANI

02/06/2008

NR



MARGARET D. SEAMAN

PRIMARY EXAMINER

GROUP 1625